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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/019,980 | 04/11/2002 | Jens Berthelsen | PHRM-0373 | 9431 |

7590 10/04/2004
Paul K Legaard
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EXAMINER

HUTSON, RICHARD G

ART UNIT PAPER NUMBER

1652

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,980

Applicant(s)

BERTHELSEN ET AL.

Examiner

Richard G. Hutson

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12,14-23,26-30 and 32-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-7,9-12,14-23,26-30 and 32-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1652

DETAILED ACTION

Applicants preliminary amendment canceling claims 8, 13, 24, 25 and 31, adding new claims 40-57 and amending claims 1, 9, 11, 12, 14, 16-19, 29, 32, 34 and 39, in the paper of 4/11/2002, is acknowledged. Claims 1, 2-7, 9, 10-12, 14-23, 26-30, 32-57 are at issue and present for examination.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-12, 14-18, 26-28, 46, 47, 51, 52 drawn to a nucleic acid which encodes a tankyrase homolog protein.

Group II, claim(s) 19-23, 40-44, 48, 53, 54 drawn to a tankyrase homolog protein.

Group III, claim(s) 29, 30, 32, 49, 50, drawn to an antibody against tankyrase homolog protein.

Group IV, claim(s) 33, 34, 45 drawn to a method of identifying a compound which binds tankyrase homolog protein.

Group V, claim(s) 35, 36, drawn to a method of identifying a compound which binds to a nucleic acid which encodes a tankyrase homolog protein.

Group VI, claim(s) 37, 38, drawn to a method of identifying a compound which modulates tankyrase homolog protein activity.

Group VII, claim(s) 39, 56, drawn to a compound which binds tankyrase homolog protein.

Art Unit: 1652

Group VIII, claim(s) 36, 37 drawn to a method of inducing an immune response against a tankyrase homolog protein.

Group IX, claim(s) 57, drawn to a compound which binds a nucleic acid that encodes a tankyrase homolog protein.

The inventions listed as Groups I through IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I through IX share a technical relationship which corresponds to a nucleic acid molecule that comprises a fragment thereof SEQ ID NO: 3 and encodes at least a portion of a tankyrase homolog protein. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Daly et al. (WO 99/15647, 4/1999) teach a nucleic acid molecule that comprises a fragment thereof SEQ ID NO: 3 and encodes at least a portion of a tankyrase homolog protein, thus anticipating the claimed genus. Thus, the shared technical feature of the groups is not a "special technical feature", unity of invention between the groups does not exist.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1652

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (571) 272-0930. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/019,980

Page 5

Art Unit: 1652

A handwritten signature in black ink, appearing to read 'R. G. Hutson', with a long horizontal stroke extending to the right.

Richard G Hutson, Ph.D.
Primary Examiner
Art Unit 1652

rg
9/29/2004